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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,346	12/03/2001	Harry A. Glorikian	P696C1	4095

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CENTRAL COAST PATENT AGENCY
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EXAMINER

CARDONE, JASON D

ART UNIT PAPER NUMBER

2145

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,346

Applicant(s)

GLORIKIAN, HARRY A.

Examiner

Jason D. Cardone

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment of the applicant, filed on 4/28/05.

Claims 8-25 are presented for further examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is dependent upon claim 1 but claim 1 has been canceled.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-4 of USPN 6,343,317 contains every element of claims 8 and 17 of the instant application and as such anticipates claims 8 and 17 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 9, 11-18 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikkola et al. ("Mikkola"), USPN 6,529,143, in view of Lumelsky, USPN 6,081,780.

8. Regarding claim 8, Mikkola discloses an information system for delivering position-related information to a portable digital appliance, comprising: a tracking

system for tracking position of the appliance [ie. position of the mobile device, Mikkola, col. 4, lines 25-59, col. 8, lines 5-24 and col. 10, lines 6-31];

a data repository comprising data entities identified by position within one or more bounded regions and [ie. position of vicinity and the movement of the mobile device, Mikkola, col. 7, line 39 – col. 8, line 24 and col. 10, lines 6-31]; and wherein the information system selects information to be provided to the appliance according to the position of the appliance and point of interest to the user [ie. position, direction of movement, and the interest of the user to the POI (point of interest), Mikkola, col. 7, line 39 – col. 8, line 24 and col. 9, lines 37-63].

Mikkola discloses retrieving POI in accordance to the interest of the user, Mikkola, col. 4, lines 25-59]. Mikkola does not specifically disclose a client profile recording a specific information subject category of interest for a user of the digital appliance and selecting information according to the specific information subject category of interest indicated in the user profile. However, Lumelsky, in the same field of endeavor, discloses a client profile recording a specific information subject category of interest for a user of the digital appliance and selecting information according to the specific information subject category of interest indicated in the user profile [Lumelsky, col. 7, lines 3-25 and col. 18, lines 19-57]. It would have been obvious to one of ordinary skill in the art to incorporate user interests, taught by Lumelsky, into the information retrieval system, taught by Mikkola, in order to have the search for information be more customized for the user.

9. Regarding claim 9, Mikkola further discloses the position of the appliance is a geographic position on the surface of the Earth [ie. GPS unit, Mikkola, col. 1, lines 13-17 and col. 9, lines 37-63].

10. Regarding claim 11, Mikkola further discloses the tracking system also record change in position relative to time, and wherein information retrieved and provided to the appliance is information associated with specific geographic positions, and is selected, at least in part, by the direction of movement of the appliance relative to one of the specific geographic positions [Mikkola, col. 8, lines 5-24 and col. 10, lines 6-31].

11. Regarding claims 12 and 13, Mikkola further discloses the information system communicates with the digital appliance on a wireless link, wherein the wireless link is a two-way link, the appliance sends periodic requests for information to the information system [Mikkola, col. 6, lines 44-58, col. 7, lines 6-16 and col. 9, lines 37-63].

12. Regarding claim 14, Mikkola further discloses the periodic requests are automatically-generated [ie. the terminal, itself, sends requests for updates of POI, Mikkola, col. 12, lines 25-51].

13. Regarding claim 15, Mikkola further discloses the periodic requests are manually generated by a user of the appliance [ie. a user may manually request POI information, Mikkola, col. 9, lines 37-50 and col. 12, lines 43-51].

14. Regarding claim 16, Mikkola further discloses information is pushed to the appliance on a pre-arranged time period [Mikkola, col. 12, lines 1-24].

15. Regarding claims 17, 18 and 20-25, they are method claims that generally correspond to the apparatus in claims 8, 9 and 11-16, respectively. Therefore, the similar limitations are disclosed under Mikkola-Lumelsky for the same reasons set forth in the rejection of claims 8, 9 and 11-16 [Supra 8, 9 and 11-16].

16. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikkola-Lumelsky as applied to claims 8 and 17 above, and further in view of Tso et al. ("Tso"), USPN 6,047,327.

17. Regarding claim 10 and 19, Mikkola-Lumelsky further discloses the data repository stores data identified by sub-regions, and position of the appliance within a sub-region is used to select information to be provided to the appliance [ie. position of the POI, Mikkola, col. 7, lines 45-61]. Mikkola-Lumelsky does not specifically disclose the data repository stores data identified by geographic regions and sub-regions within those bounded regions. However, Tso, in the same field of mobile information retrieval endeavor, discloses breaking up data by region, ie. map of California, (geographic region) and territory the client is currently located, ie regional map of California (bounded sub-region within the geographic region) [Tso, col. 11, line 65 – col. 12, line 25 and col. 19, line 60 – col. 20, line 8]. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to incorporate more regional levels, disclosed by Tso, for the data storage, disclosed by Mikkola-Lumelsky, in order better focus the information sent to the user.

Response to Arguments

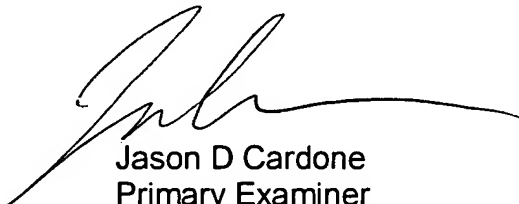
18. Applicant's arguments with respect to claims 8-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

August 19, 2005